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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/020,331

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Michael T. Milbocker

PRAXIS-5

9980

7590

11/18/2005

PROMETHEAN SURGICAL DYNAMICS LLC
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EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,331	Applicant(s) MILBOCKER, MICHAEL T.	
	Examiner Blessing M. Fubara	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-30 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-30 and 40-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Examiner acknowledges receipt of request for continued examination under 37 CFR

1.114, amendment, remarks and IDS filed 09/15/05. Claims 1-14, 17-30 and 40-48 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/15/05 has been entered.

Applicants' Remarks:

- a) The specification as originally filed has support for 10% to 30% PO, 75%EO/25%PO, 80%:20%, etc.
 - b) The claims are amended to recite that the composition is suitable for use as a biocompatible tissue-bonding adhesive composition, exposure of the adhesive to tissue or water after polymerization leads to formation of hydrogel that comprises greater than 50% water by volume.
 - c) That because the independent claims are allowable, the dependent claims are also allowable.
2. Applicant's arguments filed 09/15/05 have been fully considered but they are not persuasive.

Although, the argument with respect to the "about" 70% Or 75% is not persuasive, the rejection is withdrawn in light of the amendment to claims 1 and 30 deleting the "about."

Exposing adhesive polymer to tissue or water after polymerization and subsequent formation of hydrogel where the hydrogel formed has taken up moisture/water in excess of 50%

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is the property of the adhesive. Two adhesives that are the same would have the same properties of functions or act in the same way when exposed to tissue or water.

According to MPEP 2112.01 [R-2], "when the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established." *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In the present case, the composition/product of the prior art is the same as the claimed composition/product.

Therefore, the independent claims are not allowable and the rejection of the dependent claims is maintained.

The rejection follows.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al. (US 5,624,972).

Muller discloses polymeric compositions comprising isocyanate-terminated polymers and

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a polyisocyanate composition (column 3, lines 8-16) and the composition comprises at least two polyisocyanate compositions, one is low in NCO polyisocyanate and the other is high NCO polyisocyanate (abstract). Toluene diisocyanate (claim 6) and isophorone diisocyanate (column 6, line 45) are examples of polyisocyanates. The functionality of the polyisocyanate terminated polyol is between 2 and 8 with an excess of isocyanate composition (column 3, lines 8-16). Additionally, Muller discloses that the composition comprises at least one other free polyisocyanate composition (See column 6, lines 38-62). Muller meets the limitations of claims 1-3 and 8.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 4-7, 9-14, 17-30 and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al. (US 5,624,972).

Muller provides polymeric compositions comprising isocyanate-terminated polymers and a polyisocyanate composition as is discussed above. Muller does not specifically disclose the percent propylene oxide recited in claim 4. There is no demonstration that greater than 30% propylene oxide will not work in the composition. Future intended use carries no patentable weight in a composition claim; and if the instant composition is applicable as a tissue adhesive, the composition of Muller should also be applicable as a tissue adhesive since Muller discloses polyol and polyisocyanate.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teachings of Muller to device compositions comprising one or more polyols terminated with a polyisocyanate and free polyisocyanate. One having ordinary skill in the art would have been motivated to use the desired amounts of PO and EO that would be expected to result in a flexible polyisocyanate polymeric composition/adhesive having the inherent properties of the adhesive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600

